

## **REMARKS:**

Claims 1-34 are currently pending in the application. Claims 1-4, 11-14, 21-24 and 31 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,226,618 to *Downs* et al. ("*Downs*"). Claims 5, 8, 15, 18, 25, and 28 stand rejected under 35 U.S.C. § 103(a) over *Downs* in view of U.S. Patent No. 6,343,738 to *Ogilvie* et al. ("*Ogilvie*"). Claims 6-7, 16-17, 26-27, and 32-34 stand rejected under 35 U.S.C. § 103(a) over *Downs* in view *Ogilvie* and in further view of U.S. Patent No. 6,230,288 to *Kuo* et al. ("*Kuo*"). Claims 9, 19, and 29 stand rejected under 35 U.S.C. § 103(a) over *Downs* in view *Ogilvie* and in further view of U.S. Patent No. 4,648,047 to *Berkland* et al. ("*Berkland*"). Claims 10, 20, 30 stand rejected under 35 U.S.C. § 103(a) over *Downs* in view of U.S. Patent No. 6,094,722 to *Astola* et al. ("*Astola*").

A Final Office Action in the subject Application was mailed to the undersigned on 4 October 2005, which provides for a response period ending 4 January 2006. The Applicant filed an Amendment After Final on 1 December 2005, within two (2) months of the date of the Final Office Action. An Advisory Action was mailed to the undersigned on 12 December 2005. The Advisory Action stated that the proposed Amendments filed on 1 December 2005 will not be entered because they raise new issues that would require further consideration and/or search. (12 December 2005 Advisory Action, Page 1). The Applicant respectfully disagrees and reiterates here the arguments set forth in the Amendment After Final filed on 1 December 2005, as if fully set forth herein.

Although the Applicant believes claims 1-34 are directed to patentable subject matter, and in condition for allowance without amendment. The Applicant has canceled independent claims 1, 11, and 21 and dependent claims 5, 6, 15, 16, 25, and 26. The Applicant has also amended independent claims 31-34 to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Applicant has also amended dependent claims 2-4, 7-10, 12-14, 17-20, 22-24, and 27-30 to correct certain dependencies. By making these amendments, the Applicant makes no admission concerning the merits of the Examiner's rejection, and respectfully denies any statement or averment of the

Examiner not specifically addressed. Particularly, the Applicant reserves the right to file additional claims in this Application or through a continuation patent Application of substantially the same scope of originally filed claims 1-34. No new matter has been added.

**REJECTION UNDER 35 U.S.C. § 112:**

The Applicant thanks the Examiner for withdrawing the rejection of claims 1-34 under 35 U.S.C. § 112, second paragraph.

**EXAMINERS RESPONSE TO APPLICANT'S ARGUMENTS FILED ON 18 JULY 2005:**

**The Examiner's equations forming the foundation of the Examiner's comparison between *Downs* and amended independent claims 31-34 cannot be made**

In response to the Applicant's arguments that *Downs* fails to teach the generation of an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers as claimed in amended independent claims 31-34, the Examiner asserts that "*Downs* teaches process for packing content and metadata that corresponds to the 'a particular pattern', and such process or algorithm is done by plurality of tools, such as "Watermarking Tool" and "SC Packer Tool". The content and the metadata is available from the content provider/seller (column 9 line 15 - column 10 line 18 and Fig. 1A). (4 October 2005 Final Office Action, Page 2). The Applicant respectfully disagrees.

The Applicant maintains that *Downs* fails to disclose, teach, or suggest ***"generate[ing] an algorithm for creating a particular pattern in data associated with one or more products*** available from one or more sellers, the data comprising one or more product attribute values, seller attribute values, and product descriptions for each of the one or more products, the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products, the algorithm comprising a sifting function capable of creating the particular pattern in the data for identifying the data and the source without adversely affecting the use of the data, the sifting function is capable of altering printable American Standard

Code for Information Interchange (ASCII) characters in the data, the pattern comprising a plurality of non-printable ASCII characters inserted throughout the data according to a pre-defined arrangement, the pattern facilitating identification of a copy of the data and not affecting authorized use of the data by the one or more buyer or users associated with the buyer computers". In particular, the Examiner equates "a particular pattern" recited in amended independent claims 31-34 with the process for packing content and metadata disclosed in *Downs*. (4 October 2005 Final Office Action, Page 2). However, the process for packing content and metadata disclosed in *Downs* is performed **on data related to the content, but does not include the content itself**. (Column 9, Lines 15-32). In contrast, the algorithm recited in amended independent claims 31-34 is generated for creating a particular pattern **in data associated with one or more products** and is **applied to the data associated with the one or more products**. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Downs* and amended independent claims 31-34 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claims 31-34 from *Downs*.

### **The Proposed Prior-Art Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims**

In response to the Applicant's argument that there is no teaching, suggestion, or motivation in the references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine the references as proposed, the Examiner asserts that "[i]n this case, 'sifting function' and 'non-printable ASCII characters' are known to one of ordinary skill in the art, and they are not invented by the applicant; thus one of ordinary skill in the art would have been motivated to modify Down's teaching by including a sifting function and/or non-printable ASCII characters for better protecting the products from unauthorized access" (4 October 2005 Final Office Action, Pages 2-3). The Applicant respectfully disagrees.

The Applicant respectfully submits that this assertion by the Examiner is merely a conclusory statement and is not supported by the disclosure in *Downs* or any of the references asserted by the Examiner. **Conclusory statements regarding common**

**knowledge and common sense are insufficient to support a finding of obviousness.** *In re Lee*, 61 U.S.P.Q.2d 1434-35 (Fed. Cir. 2002). (Emphasis Added). First, it is not clear what the Examiner means by “for better protecting the products from unauthorized access” (i.e. what “better protection” or what “unauthorized access” is the Examiner referring to). Second, there is simply no disclosure, teaching, or suggestion in *Downs* of a **“algorithm comprising a sifting function capable of creating the particular pattern in the data for identifying the data and the source without adversely affecting the use of the data, the sifting function is capable of altering printable American Standard Code for Information Interchange (ASCII) characters in the data, the pattern comprising a plurality of non-printable ASCII characters inserted throughout the data according to a pre-defined arrangement,”** as recited in amended independent claims 31-34.

The Applicant maintains that the Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine the references as proposed. The Examiner merely asserts that “[i]n this case, ‘sifting function’ and ‘non-printable ASCII characters’ are known to one of ordinary skill in the art, and they are not invented by the applicant; thus one of ordinary skill in the art would have been motivated to modify Down’s teaching by including a sifting function and/or non-printable ASCII characters for better protecting the products from unauthorized access”. (4 October 2005 Final Office Action, Pages 2-3). The Applicant respectfully disagrees.

The Applicant further maintains that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in the references, either individually or in combination. The Examiner appears to be asserting that one of ordinary skill in the art at the time the invention was made would have been motivated “for better [sic] protecting the products from unauthorized access.” (4 October 2005 Final Office Action, Page 3). The Applicant respectfully disagrees. ***The Applicant respectfully requests the Examiner to point to the portions of the references which contain the teaching, suggestion, or motivation to combine the references for the Examiner’s stated***

***purported advantage.*** The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, ***the Examiner has not adequately supported the selection and combination of references to render obvious the Applicant's claimed invention.*** The Examiner's conclusory statements that "[i]n this case, 'sifting function' and 'non-printable ASCII characters' are known to one of ordinary skill in the art, and they are not invented by the applicant; thus one of ordinary skill in the art would have been motivated to modify Down's teaching by including a sifting function and/or non-printable ASCII characters for better protecting the products from unauthorized access" does not adequately address the issue of motivation to combine. (4 October 2005 Final Office Action, Pages 2-3). ***This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority.*** *Id.* (Emphasis Added). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings the references, either individually or in combination.

The Applicant respectfully submits that perhaps the Examiner is asserting Official Notice over the "sifting function" and the "non-printable ASCII characters". If so then the Applicant is confused as to what the Examiner teaches by the Official Notice or even to the extent in which the Examiner is taking Official Notice. The Applicant respectfully request clarification as to the subject matter for which Official Notice is being taken. The Applicant respectfully traverses the Official Notice because the asserted facts, as best understood

by the Applicant, are not supported by substantial documentary evidence or any type of documentary evidence and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion. (See MPEP § 2144.03). ***The Applicant respectfully requests the Examiner to produce authority for the Examiners Official Notice.***

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection". (MPEP § 2144.03). "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art ***are capable of instant and unquestionable demonstration as being well-known***. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '***capable of such instant and unquestionable demonstration as to defy the dispute***' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

***"It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. Zurko***, 258 F.3d at 1385, 59 USPQ2d at 1697. (Emphasis Added). As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)." (MPEP § 2144.03(A)).

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that ***general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete***

**evidence in the record to support these findings will not support an obviousness rejection).** The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

The Applicant respectfully submits that the Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. The Applicant further submits that the Applicant has adequately traversed the Examiners assertion of Official Notice and directs the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of claims 1-34 based on the Examiners purported Official Notice, the Applicant respectfully requests that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Applicant further requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

## **REJECTION UNDER 35 U.S.C. § 102(e):**

Claims 1-4, 11-14, 21-24 and 31 stand rejected under 35 U.S.C. § 102(e) over *Downs*.

Although the Applicant believes claims 1-34 are directed to patentable subject matter without amendment, the Applicant has canceled independent claims 1, 11, and 21 and dependent claims 5, 6, 15, 16, 25, and 26. The Applicant has also amended independent claims 31-34 to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Applicant has also amended dependent claims 2-4, 7-10, 12-14, 17-20, 22-24, and 27-30 to correct certain dependencies. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 102(e), as set forth in the Office Action.

The Applicant respectfully submits that the amendments to independent claims 31-34 have rendered moot the Examiner's rejection of claims 1-4, 11-14, and 21-24 and the Examiner's arguments in support of the rejection of claims 1-4, 11-14, and 21-24. The Applicant further submits that amended independent claims 31-34 in their current amended form contain unique and novel limitations that are not disclosed, suggested, or even hinted at in *Downs*. Thus, the Applicant respectfully submits that amended independent claims 31-34 patentably distinguish over *Downs* and dependent claims 2-4, 12-14, 22-24 and 31-34, which depend from amended independent claims 32-34, likewise patentably distinguish over *Downs*.

### ***Downs* Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims**

For example, with respect to amended independent claim 32, this claim recites:

***A system for watermarking data associated with one or more products***, the system comprising one or more software components collectively operable to:



***generate an algorithm for creating a particular pattern*** in data associated with one or more products available from one or more sellers, the ***data comprising one or more product attribute values, seller attribute values, and product descriptions for each of the one or more products***, the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products, the ***algorithm comprising a sifting function capable of creating the particular pattern in the data for identifying the data and the source without adversely affecting the use of the data***, the ***sifting function is capable of altering printable American Standard Code for Information Interchange (ASCII) characters in the data, the pattern comprising a plurality of non-printable ASCII characters inserted throughout the data according to a pre-defined arrangement***, the pattern facilitating identification of a copy of the data and not affecting authorized use of the data by the one or more buyer or users associated with the buyer computers; and

***apply the algorithm to the data to create the particular pattern in the data.*** (Emphasis Added).

Amended independent claims 31, 33, and 34 recite similar limitations. *Downs* fails to disclose each and every limitation of amended independent claims 31-34.

The Applicant respectfully submits that *Downs* has nothing to do with amended independent claim 32 limitations regarding a system, method, or software for watermarking data associated with one or more products and in particular *Downs* has nothing to do with amended independent claim 32 limitations regarding an algorithm comprising a sifting function capable of altering printable American Standard Code for Information Interchange characters in the data, the pattern comprising a plurality of non-printable American Standard Code for Information Interchange characters inserted throughout the data according to a pre-defined arrangement. Although *Downs* discloses an ability to extract metadata and to package it for electronic distribution, (Column 9, Lines 15-60), *Downs* does not disclose, teach, or suggest the generation of an algorithm for creating a particular pattern or even packing content and metadata in data associated with one or more products available from one or more sellers.

In addition, the Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Downs* fails to disclose the emphasized limitations in

amended independent claims 32-34. Specifically the Examiner acknowledges that *Downs* fails to teach "***the pattern including inserting non-printable ASCII characters throughout the data according to a pre-defined arrangement.***" (4 October 2005 Final Office Action, Pages 6-7). Thus, *Downs* cannot provide a system, method, or even software for watermarking data associated with one or more products, since as acknowledged by the Examiner, *Downs* fails to teach the pattern including inserting non-printable ASCII characters throughout the data according to a pre-defined arrangement.

### **The Applicant's Claims are Patentable over *Downs***

The Applicant respectfully submits that the allegation in the present Office Action that *Downs* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Downs* is considered to anticipate all of the limitations in amended independent claim 32. ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.*** MPEP § 2131. (Emphasis Added). The Applicant respectfully points out that "it is incumbent upon the [E]xaminer to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicant respectfully submits that the Office Action has failed to establish a *prima facie* case of anticipation in amended independent claim 32 under 35 U.S.C. § 102 with respect to *Downs* because *Downs* fails to identically disclose each and every element of the Applicant's claimed invention, arranged as they are in Applicant's claim.

With respect to amended independent claims 31, 33, and 34 each of these claims includes limitations similar to those discussed above in connection with amended independent claim 32. Thus, amended independent claims 31, 33, and 34 are considered patentably distinguishable over *Downs* for at least the reasons discussed above in connection with amended independent claim 32. Furthermore, dependent claims 2-4 which depend from amended independent claim 32, dependent claims 12-14 which depend from amended independent claim 33 and dependent claims 22-24 which depend from amended independent claim 34 are also considered patentably distinguishable over

*Downs*. Thus, dependent claims 2-4, 12-14, and 22-24 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicant submits that claims 2-4, 12-14, 22-24 and 31-34 are not anticipated by *Downs*. The Applicant further submits that claims 2-4, 12-14, 22-24 and 31-34 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 2-4, 12-14, 22-24 and 31-34 under 35 U.S.C. § 102(e) be reconsidered and that claims 2-4, 12-14, 22-24 and 31-34 be allowed.

**THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.
5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means

known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other

person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of

experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

**REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 5, 8, 15, 18, 25, and 28 stand rejected under 35 U.S.C. § 103(a) over *Downs* in view of *Ogilvie*. Claims 6-7, 16-17, 26-27, and 32-34 stand rejected under 35 U.S.C. § 103(a) over *Downs* in view *Ogilvie* and in further view of *Kuo*. Claims 9, 19, and 29 stand rejected under 35 U.S.C. § 103(a) over *Downs* in view *Ogilvie* and in further view of *Berkland*. Claims 10, 20, 30 stand rejected under 35 U.S.C. § 103(a) over *Downs* in view of *Astola*.

Although the Applicant believes claims 1-34 are directed to patentable subject matter without amendment, the Applicant has canceled independent claims 1, 11, and 21 and dependent claims 5, 6, 15, 16, 25, and 26. The Applicant has also amended independent claims 31-34 to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Applicant has also amended dependent claims 2-4, 7-10, 12-14, 17-20, 22-24, and 27-30 to correct certain dependencies. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicant respectfully submits that *Downs* or *Ogilvie*, either individually or in combination, fails to disclose, teach, or suggest each and every element of claims 5, 8, 15, 18, 25, and 28. The Applicant further submits that *Downs*, *Ogilvie*, or *Kuo*, either individually or in combination, fails to disclose, teach, or suggest each and every element of claims 6, 7, 16, 17, 26, 27, 32, 33, and 34. The Applicant still further submits that *Downs*, *Ogilvie*, *Kuo*, or *Berkland*, either individually or in combination, fails to disclose, teach, or suggest each and every element of claims 9, 19, and 29. The Applicant yet further submits that *Downs* or *Astola*, either individually or in combination, fails to disclose, teach, or suggest each and every element of claims 10, 20, and 30. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of claims 1-34 under 35 U.S.C. §

103(a) over the proposed combination of *Downs*, *Ogilvie*, *Kuo*, *Berkland*, and *Astola*, either individually or in combination.

**The Proposed *Downs-Ogilvie-Kuo* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Independent Claims 32-34**

The Applicant respectfully submits that the amendments to independent claims 32-34 have rendered moot the Examiner's rejection of claims 32-34 and the Examiner's arguments in support of the rejection of claims 32-34. The Applicant further submits that amended independent claims 32-34 in their current amended form contain unique and novel limitations that are not disclosed, suggested, or even hinted at in *Downs*, *Ogilvie*, and *Kuo*, either individually or in combination. Thus, the Applicant respectfully submits that amended independent claims 32-34 are not rendered obvious by the proposed combination of *Downs*, *Ogilvie*, or *Kuo*.

For example, with respect to amended independent claim 32, this claim recites:

**A system for watermarking data associated with one or more products**, the system comprising one or more software components collectively operable to:

**generate an algorithm for creating a particular pattern in data associated with one or more products** available from one or more sellers, the **data comprising one or more product attribute values, seller attribute values, and product descriptions for each of the one or more products**, the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products, the algorithm comprising **a sifting function capable of creating the particular pattern** in the data for identifying the data and the source **without adversely affecting the use of the data**, the **sifting function is capable of altering printable American Standard Code for Information Interchange (ASCII) characters in the data, the pattern comprising a plurality of non-printable ASCII characters inserted throughout the data according to a pre-defined arrangement**, the pattern facilitating identification of a copy of the data and not affecting authorized use of the data by the one or more buyer or users associated with the buyer computers; and

**apply the algorithm to the data to create the particular pattern in the data.** (Emphasis Added).



Amended independent claims 33 and 34 recite similar limitations. *Downs*, *Ogilvie*, or *Kuo* either individually or in combination, fail to disclose, teach, or suggest each and every element of amended independent claims 32-34.

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Downs* fails to disclose the emphasized limitations in amended independent claims 32-34. Specifically the Examiner acknowledges that *Downs* fails to teach “the **algorithm is a sifting function**” or “**the pattern including inserting non-printable ASCII characters throughout the data according to pre-defined arrangement.**” (4 October 2005 Final Office Action, Pages 5-7). However, the Examiner asserts that the cited portions of *Ogilvie* and *Kuo* disclose the acknowledged shortcomings in *Downs*. The Applicant respectfully traverses the Examiner’s assertions regarding the subject matter disclosed in *Ogilvie* and *Kuo*.

The Applicant respectfully submits that *Ogilvie* has nothing to do with amended independent claim 32 limitations regarding a system, method, or software “for watermarking data associated with one or more products” and in particular *Ogilvie* has nothing to do with amended independent claim 32 limitations regarding “**generate[ing] an algorithm for creating a particular pattern in data associated with one or more products** available from one or more sellers, the data comprising one or more product attribute values, seller attribute values, and product descriptions for each of the one or more products, the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products, the **algorithm comprising a sifting function capable of creating the particular pattern in the data for identifying the data and the source without adversely affecting the use of the data, the sifting function is capable of altering printable American Standard Code for Information Interchange (ASCII) characters in the data, the pattern comprising a plurality of non-printable ASCII characters inserted throughout the data according to a pre-defined arrangement**, the pattern facilitating identification of a copy of the data and not affecting authorized use of the data by the one or more buyer or users associated with the buyer computers”. Rather *Ogilvie* merely discloses a sampling technique based on content types which may

include ASCII text. (Column 20, Lines 8-23). The sampling technique in *Ogilvie*, merely categorizes content type and has nothing to do with inserting a plurality of non-printable ASCII characters according to a pre-defined arrangement, or any type of arrangement at all. Thus *Ogilvie* cannot provide ***“a sifting function capable of creating the particular pattern in the data for identifying the data and the source without adversely affecting the use of the data”*** or ***“a pattern comprising a plurality of non-printable ASCII characters inserted throughout the data according to a pre-defined arrangement,”*** since *Ogilvie* does not even provide a sifting function or a pre-defined arrangement for inserting non-printable ASCII characters in the first place.

The Applicant further submits that *Kuo* has nothing to do with amended independent claim 32 limitations regarding a system, method, or software “for watermarking data associated with one or more products” and in particular *Kuo* has nothing to do with amended independent claim 32 limitations regarding ***“generate[ing] an algorithm for creating a particular pattern in data associated with one or more products*** available from one or more sellers, the data comprising one or more product attribute values, seller attribute values, and product descriptions for each of the one or more products, the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products, the ***algorithm comprising a sifting function capable of creating the particular pattern in the data for identifying the data and the source without adversely affecting the use of the data***, the ***sifting function is capable of altering printable American Standard Code for Information Interchange (ASCII) characters in the data***, the ***pattern comprising a plurality of non-printable ASCII characters inserted throughout the data according to a pre-defined arrangement***, the pattern facilitating identification of a copy of the data and not affecting authorized use of the data by the one or more buyer or users associated with the buyer computers”. Rather *Kuo* discloses a method for detecting computer viruses that infect text-based files and transforms the ***“myriad” [i.e. countless, innumerable, numberless, numerous, many, multitude, or heap]*** of possible whitespace sequences with a common whitespace sequence. (Abstract and Column 5, Lines 5-38). Thus, *Kuo* cannot provide ***“a pattern*** comprising a plurality of non-printable ASCII characters inserted throughout

the data **according to a pre-defined arrangement**, since; *Kuo* does not even provide a pre-defined, pre-determined, or even an ability to calculate, estimate, or even guess at a possible definitive arrangement of inserting non-printable ASCII characters throughout the data according to a pre-defined arrangement.

The Applicant further submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Downs*, *Ogilvie*, and *Kuo*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Downs*, *Ogilvie*, and *Kuo* as proposed. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the pattern in *Downs*’ teaching to include inserting non-printable ASCII characters as taught by *Ogilvie* and *Kuo*”. (4 October 2005 Final Office Action, Page 7). The Applicant respectfully disagrees.

The Applicant further submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Downs*, *Ogilvie*, or *Kuo*, either individually or in combination. The Examiner appears to be asserting that one of ordinary skill in the art at the time the invention was made would have been motivated “for better [sic] protecting the products from unauthorized access.” (4 October 2005 Final Office Action, Page 7). The Applicant respectfully disagrees. ***The Applicant respectfully requests the Examiner to point to the portions of Downs, Ogilvie, or Kuo which contain the teaching, suggestion, or motivation to combine Downs, Ogilvie, or Kuo for the Examiner’s stated purported advantage.*** The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

(Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of *Downs*, *Ogilvie*, and *Kuo* to render obvious the Applicant's claimed invention. The Examiner's conclusory statements that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the pattern in *Downs*' teaching to include inserting non-printable ASCII characters as taught by *Ogilvie* and *Kuo*" or that "for better [sic] protecting the products from unauthorized access", does not adequately address the issue of motivation to combine. (4 October 2005 Final Office Action, Page 7). This ***factual question of motivation is material to patentability, and cannot be resolved on subjective belief*** and unknown authority. *Id.* (Emphasis Added). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of *Downs*, *Ogilvie*, or *Kuo*, either individually or in combination.

**The Proposed *Downs-Ogilvie* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 8, 18, and 28**

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Downs* fails to disclose the emphasized limitations in dependent claims 8, 18, and 28. Specifically the Examiner acknowledges that *Downs* fails to teach the pattern including a plurality of insertion, deletion, or modifications of printable ASCII characters in data according to a predefined arrangement. (4 October 2005 Final Office Action, Page 5). However, the Examiner asserts that the cited portions of *Ogilvie* disclose the acknowledged shortcomings in *Downs*. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Ogilvie*.

For example, with respect to amended dependent claim 8, this claim recites:

The system of Claim 32, wherein ***the pattern comprises a plurality of insertion, deletions, or modifications of printable*** American Standard

Code for Information Interchange (**ASCII**) **characters in the data according to a pre-defined arrangement.** (Emphasis Added).

Amended dependent claims 18 and 28 recite similar limitations. *Downs* or *Ogilvie* either individually or in combination, fail to disclose, teach, or suggest each and every element of amended dependent claims 8, 18, and 28.

The Applicant respectfully submits that *Ogilvie* has nothing to do with amended dependent claim 8 limitations regarding a particular pattern in data associated with one or more products comprising “a plurality of insertion, deletion, or modifications of printable ASCII characters in data according to a pre-defined arrangement.” Rather *Ogilvie* discloses a technique for facilitating transactions involving digital goods through a broker. (Abstract). *Ogilvie* merely discloses a sampling technique based on content types which may include ASCII text. (Column 20, Lines 8-23). However, the sampling techniques performed by the system in *Ogilvie* are performed only on digital goods. *Ogilvie* does not disclose, suggest, or even hint at **a particular pattern in data associated with one or more products** according to a predefined arrangement. Thus *Ogilvie* cannot provide a system, method, or even software for watermarking data with one or more products comprising one or more software components collectively operable to generate an algorithm for creating **a particular pattern in data associated with one or more products** available from one or more sellers that is a sifting function or **a pattern in data associated with one or more products** comprising “a plurality of insertion, deletion, or modifications of printable ASCII characters in data according to a predefined arrangement.”

The Applicant further submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Downs* and *Ogilvie*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Downs* and *Ogilvie* as proposed. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time the

invention was made to allow the pattern in *Downs*' teaching to include a plurality of insertion, deletion, or modifications of printable ASCII characters in data according to a predefined arrangement". (4 October 2005 Final Office Action, Page 5). The Applicant respectfully disagrees.

The Applicant further submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Downs* or *Ogilvie*, either individually or in combination. The Examiner appears to be asserting that one of ordinary skill in the art at the time the invention was made would have been motivated "for better [sic] protecting the products from unauthorized access." (4 October 2005 Final Office Action, Page 5). The Applicant respectfully disagrees. ***The Applicant respectfully requests the Examiner to point to the portions of Downs or Ogilvie which contain the teaching, suggestion, or motivation to combine Downs or Ogilvie for the Examiner's stated purported advantage.*** The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of *Downs* and *Ogilvie* to render obvious the Applicant's claimed invention. The Examiner's conclusory statements that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the pattern in *Downs*' teaching to include a plurality of insertion, deletion, or modifications of printable ASCII characters in data according to a predefined arrangement" or that "for better [sic] protecting the products from unauthorized access", does not adequately address the issue of motivation to combine. (4 October 2005 Final Office Action, Page 5). This ***factual question of motivation is material to patentability, and cannot be resolved on subjective belief***

**and unknown authority.** *Id.* (Emphasis Added). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of *Downs* or *Ogilvie*, either individually or in combination.

**The Proposed *Downs-Ogilvie-Kuo* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 7, 17, and 27**

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Downs* fails to disclose the emphasized limitations in amended dependent claims 7, 17 and 27. Specifically the Examiner acknowledges that *Downs* fails to teach the limitations of dependent claims 7, 17, and 27. (4 October 2005 Final Office Action, Pages 5-6). However, the Examiner asserts that the cited portions of *Ogilvie* and *Kuo* disclose the acknowledged shortcomings in *Downs*. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Ogilvie* and *Kuo*.

For example, with respect to amended dependent claim 7, this claim recites:

The system of Claim 32, wherein ***the pattern comprises a particular set of non-printable ASCII characters appearing after each instance of a particular group of characters in the data.*** (Emphasis Added).

Amended dependent claims 17 and 27 recite similar limitations. *Downs*, *Ogilvie*, or *Kuo*, either individually or in combination, fail to disclose, teach, or suggest each and every element of amended dependent claims 7, 17, and 27.

The Applicant respectfully submits that *Ogilvie* has nothing to do with amended dependent claim 7 limitations regarding a particular pattern in data associated with one or more products comprising "***a particular set of non-printable ASCII characters appearing after each instance of a particular group of characters in the data.***" Rather *Ogilvie* discloses a technique for facilitating transactions involving digital goods through a broker. (Abstract). *Ogilvie* merely discloses a sampling technique based on

content types which may include ASCII text. (Column 20, Lines 8-23). *Ogilvie* does not disclose a sampling technique or any technique that comprises a pattern of ***a particular set of non-printable ASCII characters appearing after each instance*** or at any instance of the sampling technique. In fact, the sampling technique disclosed in *Ogilvie* does not disclose ***“a set of non-printable characters”*** but merely describes ASCII text. (Column 20, Lines 8-23). In addition, the sampling technique disclosed in *Ogilvie* does not disclose ***“appearing after each instance of a particular group of characters in the data”*** but merely discloses sampling that could be done by deleting every Nth character. (Column 20, Lines 8-23). Thus *Ogilvie* cannot provide a system, method, or even software for watermarking data with one or more products comprising one or more software components collectively operable to generate an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers that is a sifting function or a pattern in data associated with one or more products comprising ***“a particular set of non-printable ASCII characters appearing after each instance of a particular group of characters in the data.”***

The Applicant further submits that *Kuo* has nothing to do with amended dependent claim 7 limitations regarding a particular pattern in data associated with one or more products comprising ***“a particular set of non-printable ASCII characters appearing after each instance of a particular group of characters in the data.”*** Rather *Kuo* discloses a method for detecting computer viruses that infect text-based files and transforms the “myriad” (countless, innumerable, numberless, numerous, many, multitude, or heap) of possible whitespace sequences with a common whitespace sequence. (Abstract and Column 5, Lines 5-38). ***Even assuming for the sake of argument that Kuo discloses a particular set of non-printable ASCII characters, which it does not,*** there is no disclosure, teaching, or suggestion in *Kuo* to generate an algorithm for creating a particular pattern ***“appearing after each instance of a particular group of characters in the data.”*** Thus, *Kuo* cannot provide a system, method, or even software for watermarking data with one or more products comprising one or more software components collectively operable to generate an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers that is a sifting function or a pattern in data associated with one or



more products comprising a particular pattern in data comprising “**a particular set of non-printable ASCII characters appearing after each instance of a particular group of characters in the data**”, since, *Kuo* does not even provide a particular set of non-printable ASCII characters appearing after each instance of a particular group of characters or even after each sequence of characters.

The Applicant further submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Downs*, *Ogilvie*, and *Kuo*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Downs*, *Ogilvie*, and *Kuo* as proposed. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the pattern in *Downs*’ teaching to include inserting non-printable ASCII characters as taught by *Ogilvie* and *Kuo*”. (4 October 2005 Final Office Action, Page 6). The Applicant respectfully disagrees.

The Applicant further submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Downs*, *Ogilvie*, or *Kuo*, either individually or in combination. The Examiner appears to be asserting that one of ordinary skill in the art at the time the invention was made would have been motivated “for better [sic] protecting the products from unauthorized access.” (4 October 2005 Final Office Action, Page 6). The Applicant respectfully disagrees. ***The Applicant respectfully requests the Examiner to point to the portions of Downs, Ogilvie, or Kuo which contain the teaching, suggestion, or motivation to combine Downs, Ogilvie, or Kuo for the Examiner’s stated purported advantage.*** The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based***

***upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of *Downs*, *Ogilvie*, and *Kuo* to render obvious the Applicant's claimed invention. The Examiner's conclusory statements that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the pattern in *Downs*' teaching to include inserting non-printable ASCII characters as taught by *Ogilvie* and *Kuo*" or that "for better [sic] protecting the products from unauthorized access", does not adequately address the issue of motivation to combine. (4 October 2005 Final Office Action, Page 6). This ***factual question of motivation is material to patentability, and cannot be resolved on subjective belief*** and unknown authority. *Id.* (Emphasis Added). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of *Downs*, *Ogilvie*, or *Kuo*, either individually or in combination.

**The Proposed *Downs-Ogilvie-Berkland* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 9, 19, and 29**

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Downs* and *Ogilvie* fail to disclose the emphasized limitations in amended dependent claims 9, 19 and 29. Specifically the Examiner acknowledges that *Downs* and *Ogilvie* fail to teach "the pattern comprises each instance of a particular group of characters in the data being underscored throughout the data." (4 October 2005 Final Office Action, Pages 7-8). However, the Examiner asserts that the cited portions of *Berkland* disclose the acknowledged shortcomings in *Downs* and *Ogilvie*. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Berkland*.

For example, with respect to amended dependent claim 9, this claim recites:

The system of Claim 32, wherein ***the pattern comprises each instance of a particular group of characters*** in the data ***being underscored throughout the data***. (Emphasis Added).

Amended dependent claims 19 and 29 recite similar limitations. *Downs, Ogilvie, or Berkland*, either individually or in combination, fail to disclose, teach, or suggest each and every element of amended dependent claims 9, 19, and 29.

The Applicant further submits that *Berkland* has nothing to do with amended dependent claim 9 limitations regarding a particular pattern in data associated with one or more products comprising “***each instance of a particular group of characters*** in the data ***being underscored*** throughout the data.” Rather *Berkland* discloses a printer function that allows underscored text to be printed. (Column 10, Lines 12-30). The Applicant respectfully submits that *Berkland* does not disclose, teach, or even hint at ***each instance of a particular group of characters in the data being underscored***. It appears that the Examiner is somehow equating “***each instance of a particular group of characters in the data being underscored***” recited in amended dependent claim 9 with the printer function, in *Berkland*, that allows underscored text to be printed. (4 October 2005 Final Office Action, Pages 7-8). However, the underscored text in *Berkland*, may be accomplished by either a word processor underscoring a text data stream (and sending it to a printer) or by sending data to a printer, where the printing of a line including underscored text takes two printing passes without an intervening line feed, albeit a slow printing process. (Column 10, Lines 12-30). In contrast, the algorithm recited in amended dependent claim 9 is generated for creating a particular pattern and is applied to “***each instance of a particular group of characters in the data being underscored***.” Thus, *Berkland* cannot provide a particular pattern in data comprising “***each instance of a particular group of characters*** in the data ***being underscored*** throughout the data”, since, *Berkland* does not even provide for the ability to underscore a particular group of characters in the first place. In addition, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Berkland* and amended dependent claim 9 cannot be

made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended dependent claim 9 from *Berkland*.

The Applicant further submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Downs*, *Ogilvie*, and *Berkland*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Downs*, *Ogilvie*, and *Berkland* as proposed. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the particular group of characters in the teaching of *Downs* modified by *Ogilvie* to be underscored throughout the data”. (4 October 2005 Final Office Action, Page 8). The Applicant respectfully disagrees.

The Applicant further submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Downs*, *Ogilvie*, or *Berkland*, either individually or in combination. The Examiner appears to be asserting that one of ordinary skill in the art at the time the invention was made would have been motivated “because this would provide sellers more choices with additional various patterns that can be added to the data so that the sellers’ products can be better [sic] protected.” (4 October 2005 Final Office Action, Page 8). The Applicant respectfully disagrees. ***The Applicant respectfully requests the Examiner to point to the portions of Downs, Ogilvie, or Berkland which contain the teaching, suggestion, or motivation to combine Downs, Ogilvie, or Berkland for the Examiner’s stated purported advantage.*** The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

(Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of *Downs*, *Ogilvie*, and *Berkland* to render obvious the Applicant's claimed invention. The Examiner's conclusory statements that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the particular group of characters in the teaching of *Downs* modified by *Ogilvie* to be underscored throughout the data" or that "because this would provide sellers more choices with additional various patterns that can be added to the data so that the sellers' products can be better [sic] protected", does not adequately address the issue of motivation to combine. (4 October 2005 Final Office Action, Page 8). This ***factual question of motivation is material to patentability, and cannot be resolved on subjective belief*** and unknown authority. *Id.* (Emphasis Added). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of *Downs*, *Ogilvie*, or *Berkland*, either individually or in combination.

### **The Proposed *Downs-Astola* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 10, 20, and 30**

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Downs* fails to disclose the emphasized limitations in amended dependent claims 10, 20, and 30. Specifically the Examiner acknowledges that *Downs* fails to teach "determining a first sum of numerical values of bytes representing the data stored in the one or more databases for later comparison with a second sum of numerical values of bytes representing data from another source to determine whether the data from the other source is a copy of the data from the one or more databases." (4 October 2005 Final Office Action, Page 8). However, the Examiner asserts that the cited portions of *Astola* disclose the acknowledged shortcomings in *Downs*. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Astola*.

For example, with respect to amended dependent claim 9, this claim recites:

The system of Claim 32, wherein ***the software components*** are collectively further operable to ***determine a first sum of numerical values of bytes representing the data stored in the one or more databases for later comparison with a second sum of numerical values of bytes representing data from another source to determine whether the data from the other source is a copy of the data from the one or more databases.*** (Emphasis Added).

Amended dependent claims 20 and 30 recite similar limitations. *Downs* or *Astola*, either individually or in combination, fail to disclose, teach, or suggest each and every element of amended dependent claims 10, 20, and 30.

The Applicant further submits that *Astola* has nothing to do with amended dependent claim 10 limitations regarding software components operable to determine “a first sum of numerical values of bytes representing the data stored in the one or more databases for later comparison with a second sum of numerical values of bytes representing data from another source to determine whether the data from the other source is a copy of the data from the one or more databases.” Rather *Astola* describes a checksum method associated with image files. (Column 1, Lines 45-54). In fact, the image disclosed in *Astola* is a two-dimensional still image produced by a photographic apparatus. (Column 1, Lines 5-15). In contrast, the algorithm recited in amended dependent claim 10 is generated for ***“creating a particular pattern in data associated with one or more products available from one or more sellers and comprising one or more product attribute values, seller attribute values, and product descriptions for each of the one or more products.”*** The checksum method in *Astola*, associated with still images, has nothing to do with the limitations in amended dependent claim 10. *Astola* does not disclose, suggest, or even hint at ***an algorithm generated for creating a particular pattern in data associated with one or more products*** and operable to “determine a first sum of numerical values of bytes representing the data stored in the one or more databases for later comparison with a second sum of numerical values of bytes representing data from another source to determine whether the data from the other source is a copy of the data from the one or more databases.” Thus, *Astola* cannot “determine a first sum of numerical values of bytes representing the data stored

in the one or more databases for later comparison with a second sum of numerical values of bytes representing data from another source to determine whether the data from the other source is a copy of the data from the one or more databases”, since, *Astola* only discloses a two-dimensional still image produced by a photographic apparatus.

The Applicant further submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Downs* and *Astola*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Downs* and *Astola* as proposed. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow *Downs*’ teaching to include the feature of whether a data is original by comparing the sum of numerical byte values of the data with the checksum of the original data.” (4 October 2005 Final Office Action, Page 8). The Applicant respectfully disagrees.

The Applicant further submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Downs* or *Astola*, either individually or in combination. The Examiner appears to be asserting that one of ordinary skill in the art at the time the invention was made would have been motivated “for quickly determining the source of the data.” (4 October 2005 Final Office Action, Page 8). The Applicant respectfully disagrees. ***The Applicant respectfully requests the Examiner to point to the portions of Downs or Astola which contain the teaching, suggestion, or motivation to combine Downs or Astola for the Examiner’s stated purported advantage.*** The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed***

***invention***, and that ***any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of *Downs* and *Astola* to render obvious the Applicant's claimed invention. The Examiner's conclusory statements that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow *Downs*' teaching to include the feature of whether a data is original by comparing the sum of numerical byte values of the data with the checksum of the original data" or "for quickly determining the source of the data", does not adequately address the issue of motivation to combine. (4 October 2005 Final Office Action, Page 8). This ***factual question of motivation is material to patentability, and cannot be resolved on subjective belief*** and unknown authority. *Id.* (Emphasis Added). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of *Downs* or *Astola*, either individually or in combination.

#### **The Applicant's Claims are Patentable over the Proposed *Downs-Ogilvie-Kuo-Berkland-Astola* Combination**

With respect to amended independent claims 31, 33, and 34 each of these claims includes limitations similar to those discussed above in connection with amended independent claim 32. Thus, amended independent claims 31, 33, and 34 are considered patentably distinguishable over the proposed combination of *Downs*, *Ogilvie*, *Kuo*, *Berkland*, and *Astola* for at least the reasons discussed above in connection with amended independent claim 32.

With respect to dependent claims 7-10, 17-20, and 27-30: claims 7-10 depend from amended independent claim 32; claims 17-20 depend from amended independent claim 33; and claims 27-30 depend from amended independent claim 34. As mentioned above, each of amended independent claims 33 and 34 includes limitations similar to those



discussed above in connection with amended independent claim 32. Thus, amended independent claims 33 and 34 are considered patentably distinguishable over *Downs*, *Ogilvie*, *Kuo*, *Berkland*, and *Astola* for at least the reasons discussed above in connection with amended independent claim 32. Thus, dependent claims 7-10, 17-20, and 27-30 are considered patentably distinguishable over the proposed combination of *Downs*, *Ogilvie*, *Kuo*, *Berkland*, and *Astola* for at least the reasons of depending from an allowable claim and are therefore considered to be in condition for allowance.

For at least the reasons set forth herein, the Applicant submits that claims 7-10, 17-20, 27-30, and 31-34 are not rendered obvious by the proposed combination of *Downs*, *Ogilvie*, *Kuo*, *Berkland*, and *Astola*. The Applicant further submits that claims 7-10, 17-20, 27-30, and 31-34 are not rendered obvious by the proposed combination of *Downs*, *Ogilvie*, *Kuo*, *Berkland*, and *Astola* and are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 7-10, 17-20, 27-30, and 31-34 under 35 U.S.C. § 103(a) be reconsidered and that claims 7-10, 17-20, 27-30, and 31-34 be allowed.

#### **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there ***must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) ***must teach or suggest all the claim limitations***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and ***not based on applicant's disclosure***. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to **suggest** the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

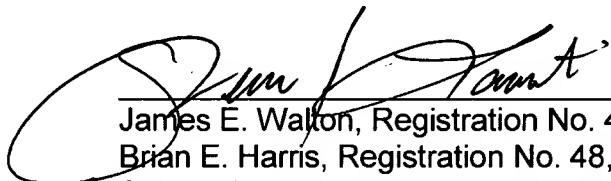
In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed in duplicate concurrently herewith to facilitate the processing of this deposit account authorization. **The Commissioner is hereby authorized to charge the RCE Fee of \$790.00 to Deposit Account No. 500777.** Because the Amendment After Final was filed within two (2) months of the date of the Final Office Action and this Amendment is filed prior to the ending of the response period 30 December 2005 of the Final Office Action mailed on 30 September 2005, no additional fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any additional fees that may be required, or credit any overpayments, to **Deposit Account No. 500777.**

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

12/29/05  
Date



James E. Walton, Registration No. 47,245  
Brian E. Harris, Registration No. 48,383  
Steven J. Laureanti, Registration No. 50,274  
Daren C. Davis, Registration No. 38,425  
Michael Alford, Registration No. 48,707  
Law Offices of James E. Walton, P.L.L.C.  
1169 N. Burleson Blvd., Suite 107-328  
Burleson, Texas 76028  
(817) 447-9955 (voice)  
(817) 447-9954 (facsimile)  
jim@waltonpllc.com (e-mail)

**CUSTOMER NO. 53184**  
**ATTORNEYS AND AGENTS FOR APPLICANT**